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### REMARKS/ARGUMENTS

Reexamination and reconsideration of this Application, withdrawal of the rejections, and formal notification of the allowability of all claims as now presented are earnestly solicited in light of the above amendments and remarks that follow. Claims 1-49 are pending.

The Office Action includes five rejections under 35 U.S.C. §103(a) involving a combination of the Maeda reference with one or more additional references. Specifically, Claims 1-15 and 17-18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Maeda reference in view of U.S. Patent No. 5,773,487 to Sokol, U.S. Patent No. 5,260,350 to Wright and U.S. Patent No. 5,571,570 to Lake. Claims 16, 19-21, 26, 28-32, 35, 39-42 and 43-46 stand rejected as being unpatentable over the Maeda, Sokol, Wright and Lake references, and further in view of either U.S. Patent No. 5,126,005 to Blake or U.S. Patent No. 4,585,519 to Jaffe *et al.* Claims 22-23, 27, 33-34, 37-38, and 48-49 stand rejected as being unpatentable over the combination of the Maeda, Sokol, and Blake or Jaffe references. Claims 24-25 and 36 stand rejected as being unpatentable over the Maeda reference in view of either Blake or Jaffe, further in view of Sokol and further in view of U. S. Patent No. 6,136,880 to Snowwhite *et al.* Claim 47 stands rejected as being unpatentable over the Maeda and Sokol references in view of either Blake or Jaffe and further in view of U.S. Patent No. 4,716,270 to Gnanamuthu *et al.* Applicant respectfully traverses these rejections.

Applicant continues to urge that one of ordinary skill in the art would have no motivation to combine the Maeda and Sokol references as contemplated by the Examiner. The Maeda reference is directed to water-based maskant compositions and merely describes a prior art maskant composition that requires extensive drying to remove the water present in the composition. The Maeda reference notes in columns 1-2 that prior attempts to formulate a water-based maskant produced inferior results due to interaction of the coating with the alkali etchant bath (e.g., swelling of the mask), poor coating workability and poor peelability. The Maeda reference teaches that the water-based formulation described therein provides good peelability and coating characteristics, as well as resistance to chemical attack. Clearly, all of the above characteristics are crucial to the application described in Maeda (i.e., a chemical milling maskant).

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The Sokol reference is directed to compositions for use as finishing coatings for household items (see column 1, lines 18-44). There is absolutely no suggestion in the Sokol reference that the compositions described therein would be suitable for use as a peelable maskant composition resistant to an etching bath as required in the Maeda reference, as well as the Jaffe and Blake references. Sokol does not mention chemical milling maskant as a possible application for the coatings described therein. Further, there is nothing in the Sokol reference that describes the peelability or chemical resistance characteristics of the coatings discussed therein, which is not surprising since the focus in Sokol is on finishing coatings that are not intended for exposure to harsh chemical attack or intended to be peeled.

The Examiner has not explained why one of ordinary skill in the art would have the reasonable belief that the coatings of Sokol would meet the stringent requirements of a chemical milling maskant. The Examiner's response to arguments in the most recent office action does not address Applicant's argument in this regard. It is not sufficient to say that one of ordinary skill in the art would be motivated to substitute the coating formulation of Sokol in the application described in Maeda simply because Sokol mentions metal as a possible substrate. One of ordinary skill in the art would certainly read the Maeda reference as requiring a coating that meets a number of performance criteria other than simply being capable of adhering to metal. Peelability and chemical resistance, for instance, are key requirements described in Maeda. The Examiner has not explained how the Sokol reference would suggest that the coatings described therein would meet such requirements. Applicants respectfully submit that Sokol cannot be read to suggest such characteristics and only impermissible hindsight would lead one to the combination proposed in the office action. One of ordinary skill in the art would simply find nothing in Sokol that provides a reasonable expectation that the Sokol coatings would function successfully in the application described in Maeda, which undermines any prima facie argument of obviousness based on these two references.

This conclusion becomes inescapable when considered in light of the discussion in Maeda of failed prior attempts to produce a workable maskant that avoids the use of volatile organic solvents. Due to the harsh environment produced by chemical milling baths and the need for peelability and good coating characteristics, it is difficult to produce a coating suitable

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for use as a maskant in a chemical milling application. This is made abundantly clear in the background discussion of Maeda. Sokol provides nothing to lead one of ordinary skill in the art to reasonably believe that the coatings of Sokol would have the necessary characteristics needed for a successful chemical milling maskant. Since the Examiner has failed to rebut this argument, Applicant requests reconsideration and withdrawal of all rejections that rely on a combination of Maeda and Sokol.

Applicant also continues to traverse the Examiner's allegation that "Maeda, Sokol, Lake, and Wright all relate to the same art of radiation curing for polymerizable acrylate compositions." Similarly, Applicant traverses the Examiner's assertion that Maeda describes curing of an acrylate coating after it has been deposited. The portion of column 7 relied upon by the Examiner mentions drying of the coating, not curing. A drying step would be understood by one of ordinary skill in the art to mean evaporation of water. Drying and curing are not synonymous. Curing implies a polymerization or cross-linking reaction, which clearly does not occur after coating deposition in Maeda. Applicant directs the Examiner's attention to the summary section of Maeda where it states that the maskant composition includes a copolymer (a), which obviously suggests that polymerization has already taken place. The Maeda reference teaches that the copolymer (a) can be prepared using the monomers, emulsifiers, and initiators described in columns 3-4. However, it is clear that the copolymer is formed by emulsion polymerization and then mixed with the remaining components (See column 5, lines 43-47, and the examples which include headings reciting "Preparation of copolymer latex (a)" and separate headings entitled "Preparation of water based maskant composition"). Thus, there is no support for the Examiner's contention that Maeda is directed to radiation curing, and particularly no support for the contention that a curing step takes place after depositing the coating described in Maeda. Thus, Maeda does not suggest the steps of applying a radiation curable composition and then exposing the coated substrate to actinic radiation to cure the maskant as recited in Claim 1 of the present application.

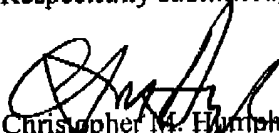
For the reasons set forth above, Applicant respectfully requests reconsideration and withdrawal of all rejections. It is believed that all pending claims are now in condition for

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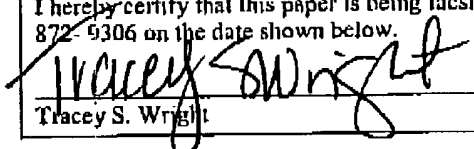
immediate allowance. It is requested that the Examiner telephone the undersigned should the Examiner have any comments or suggestions in order to expedite examination of this case.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

  
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 Tracey S. Wright	<u>4/30/04</u> Date